

JUL 24 2006

Ser. No. 09/825,328

REMARKS

Claims 1, 11, 15-16, 21, 25-26, 31, 38-39, 41, and 45 are in the case and presented for consideration.

Claims 1, 11, 21, 31, 38-39, 41, and 45 were rejected under 35 U.S.C. §103(a) as being obvious in view of Published U.S. Patent Application 2004/0116088 to Ellis (hereinafter Ellis) in combination with U.S. Patent No. 5,590,246 to Asgharzadeh (Asgharzadeh).

It is well settled that the burden of establishing a *prima facie* case of unpatentability resides with the United States Patent and Trademark Office. *In re Plasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To meet the burden of establishing a *prima facie* case, the Office must point out where each claimed element and limitation of the claims is found in the cited references. *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (Bd. Pat. App. & Inter. 2005). The Office must also explain the rejection with reasonable specificity. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). MPEP guidelines per 1.104(c)(2) of Title 37 of the Code of Federal regulations and section 707 of the MPEP state that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified". If the Patent Office does not produce a *prima facie* case of unpatentability, then without more, the applicant is entitled to a grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

Applicants respectfully submit that the Office has not established a *prima facie* of obviousness. The Office has not pointed out where each claimed element and limitation of the claims is found in the cited references.

The pending claims have been selectively amended without introduction of any new matter.

Claim 1, among others, recites:

"determining preferences of said user under said one or more observed environmental characteristics"

Claim 1 further recites:

wherein said one or more observed environmental characteristics includes at least one of a weather condition; a characteristic of motion of said user, a location, and one or more characteristics of said location

Ser. No. 09/825,328

The Office states that "Ellis discloses...- observing preferences of said user under said under said one or more environmental characteristics (see page 5, line 17 to page 6, line 3 regarding the user's preferences or profile." The Office does not identify any single feature of Ellis which corresponds to the claimed step of "determining preferences of said user under said one or more observed environmental characteristics." The Office has not shown that at least one of the cited references teaches user preference determination from at least one of a weather condition, a characteristic of motion of said user, a location, and one or more characteristics of said location.

Next, applicants respectfully submit that claim 1 is patentable because it recites at least one element or limitation not taught or suggested by either of the cited references alone or in combination.

First, Ellis does not teach or suggest observing either a "weather condition" or a "characteristic of motion." Second, although Ellis teaches that a "device may determine the geographic location," Ellis does not teach or suggest determining user preferences under one or more observed environmental characteristics, namely, as recited, a location or one or more characteristics of the location. According to claim 1, location is recited as one criteria for determining a user's preferences. In contrast, Ellis fails to teach monitoring location for determining the user's preferences. While a GPS is taught by Ellis, it is used for reasons different from determining user preferences as claimed in claim 1. Examples of location uses in Ellis are as follows:

1. monitoring radio stations accessible at the determined location and comparing them to the preferred stations by the user. Ellis, paragraph [0179]
2. filtering the database so as to determine if a preferable radio station is accessible at the determined location of the user. Ellis, paragraph [0180]

Neither of the above reasons plays any role in determining "preferences of the user," as claimed in claim 1. In accordance with Ellis, a user may enjoy an N station. Whether this station is listened to by the user in New York City or in the middle of a corn field somewhere in Nebraska, for example, is of no consequence for Ellis, which, thus, does not teach that a geographical location influences the user's preferences, as recited by Claim 1. The criterion employed by Ellis may be, for example, a time of the day or a day of the week. Ellis, paragraph [0184]. But neither a location nor a characteristic of location,

Ser. No. 09/825,328

as recited by Claim 1, (in addition to other recited factors) is used by Ellis for determining the user's preferences.

Moreover, neither Ellis or Asgharzadeh teaches or suggests

**"generating a recommendation score for said item based on features of said item and said observed preferences of said user under said one or more observed environmental characteristics"**

Since neither of the cited references teaches this limitation, a combination of these references cannot yield the structure as recited by Claim 1, which is, thus, patentable over the cited combination.

Furthermore, applicants respectfully submit that Asgharzadeh is non-analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986)

Asgharzadeh teaches weighting the quality of prints. First, in contrast to the disclosure (and Ellis), Asgharzadeh does not teach a radio communication system and, thus, operates in a different field. And second, Asgharzadeh attacks a problem associated with evaluating the quality of prints based on an objective criterion – a decision made by experts. Asgharzadeh, col. 2, lines 44-48. In contrast, the recited structure (and Ellis) utilizes a subjective criterion—a decision made by a system and based on listening preferences by a listener.

In addition, the cited references are not combinable as the Office suggests because there is no motivation for an artisan to utilize a score of Asgharzadeh in a system taught by Ellis, since a user in Ellis would have to entirely rely on an expert's evaluation, as taught by Asgharzadeh. Such a reliance, however, would radically contradict to Ellis disclosing a user-decision based system. As a consequence, an artisan would not be motivated to combine the cited references since the operational principle of Ellis would be compromised. (See, *In re Rouffet*, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.)

Claims 11, 38, and 39 recite similar limitations and, as a consequence, are patentable over the cited combination, too.

Claims 41 and 45 depend from claims 38 and 39 and are believed to be patentable for at least the same reasons as claims 38 and 39.

Ser. No. 09/825,328

Claim 31 recites "a characteristic of motion of said user". Neither Ellis nor Asgharzadeh teaches or suggests a characteristic of motion of the user.

Accordingly, the application and claims are believed to be in condition for allowance, and favorable action is respectfully requested. No new matter has been added.

If any issues remain which may be resolved by telephonic communication, the Examiner is respectfully invited to contact the undersigned at the number below, if such will advance the application to allowance.

Respectfully submitted,

By 

Yuri Kateshov, Reg. 34,466

Attorney

(914) 723-2062

**MAIL ALL CORRESPONDENCE TO :**

Yan Glickberg, Registration No. 51,742

US PHILIPS CORPORATION

P.O. BOX 3001

Briarcliff Manor, NY 10510-8001

Phone : (914) 333-9618

Fax : (914) 332-0615